



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RESPONSE TO THE DECEMBER 7, 2004 OFFICE ACTION

APPLICANT: Rainer Graumann GROUP ART UNIT: 2644
SERIAL NO.: 09/778,497 EXAMINER: Justin I. Michalski
FILED: February 7, 2001 CONFIRMATION NO.: 8814
TITLE: "GARMENT-WORN MICROPHONE, AND COMMUNICATION SYSTEM AND METHOD EMPLOYING SUCH A MICROPHONE FOR VOICE CONTROL OF DEVICES"

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

SIR:

In the Office Action dated December 7, 2004, an election of species requirement was imposed, between the species of Figure 1 comprising a microphone integrated into a surgical mask, and the species of Figure 2, comprising a larynx microphone integrated into a neck band. Under 35 U.S.C. §121, the Examiner required election of a single disclosed species for prosecution on the merits, to which the claims shall be restricted if no generic claim is held to be allowable.

Applicant notes that the Examiner stated that claims 1-20 were pending in the application, and therefore claims 1-20 were subject to the election of species requirement. Claim 14, however, was cancelled in Amendment "A" filed July 29, 2004, and therefore only claims 1-13 and 15-20 are pending in the application and are the subject of the election of species requirement.

Applicant respectfully traverses the election of species requirement for the following reasons.

In the Office Action dated February 17, 2004, an action of the merits was rendered with regard to all of then-pending claims 1-20. No election of species requirement was imposed at that time. Applicant therefore responded to the Action on the merits with regard to all of claims 1-13 and 15-20 (claim 14, as noted above having been cancelled). In that response, the originally-used term "face mask" was changed to "surgical mask," however this editorial change cannot have been the reason why an election of species requirement was not imposed in the first Office Action since face masks and surgical masks are both classified in the classification that the Examiner has designated for Species I in the December 7, 2004 Office Action.

The purpose of imposing an election of species requirement is to relieve the Examiner from having to conduct searching in different classifications respectively for patentably distinct species. In the present application, however, the Examiner has already conducted such searching, for the purpose of rendering the action on the merits for all of original claims 1-20, in the February 17, 2004 Office Action. Applicant submits the Examiner has no statutory authority to impose an election of species requirement *after* the Examiner has already searched in the same classifications that the Examiner has now designated for the (allegedly) patentably distinct species. The purpose for imposing an election of species requirement is rendered moot when this searching, as here, has already been done.

Moreover, by virtue of the fact that the first Office Action treated all of the claims on the merits, Applicant had no choice but to respond on the merits to the rejection of all of the original claims. If the Applicant is now required to elect only some of those claims for further prosecution, Applicant will have been required to

make statements in the record going to the merits of the non-elected claims, which may possibly be used against the Applicant if and when a patent issues for this application and is asserted against an infringer.

It is understandable that the Examiner may believe *future* searching will be reduced by now imposing an election of species requirement, however, this convenience to the Examiner must be weighed against the prejudice that will be caused to the Applicant by first rendering an action on the merits, to which Applicant had no choice but to file a complete response. When an Applicant makes an election of species, this election cannot be reversed, except under extremely unusual circumstances. The same requirements should apply to the Examiner. If the Examiner chooses to render an action on the merits for all of the claims, the Examiner should not be permitted to subsequently switch positions, and decide that an election of species requirement should be imposed. As noted above, there is no significant difference in the present claim language from the original claim language that would have precluded the Examiner from making an election of species in the first Office Action, instead of rendering an action on the merits for all of the claims.

Applicant recognizes that even when an election of species requirement is traversed, Applicant is required to make a provisional election. Accordingly, Applicant provisionally elects the species of Figure 1. Claims 1, 2, 4-13, 15 and 17-20 are readable on the elected species.

Withdrawal of the election of species requirement and continued examination
of all pending claims on the merits are therefore respectfully requested.

Submitted by,

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